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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,618	12/18/2000	James M. Barton	60097-0195	9889
29989 7590 10/24/2008 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
EXAMINER SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
2424				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,618

Applicant(s)

BARTON, JAMES M.

Examiner

JAMES SHELEHEDA

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 14 and 16-36 is/are pending in the application.
- 4a) Of the above claim(s) 4, 17 and 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14, 16, 18 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/15/08 has been entered.

Response to Arguments

2. Applicant's arguments with respect to receiving a program segment containing a beginning portion of a commercial break have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments concerning "either skip past the menu...or select a particular item" on page 12, it is noted that the claim is recited in the alternative. As Zigmond discloses wherein the user may select an item, it meets the claim limitations.

3. Applicant's arguments filed 09/15/08, regarding claims 30-31 have been fully considered but they are not persuasive.

On page 8, of applicant's response, applicant argues that claims 30-31 do not cite that the features in said claims are performed by the DVR by appending information into the beginning portion of individual advertisements.

In response, the restriction requirement of 01/18/07, identified two separate sub-combinations usable together. One was directed to enhancing viewership during a *commercial break*, and the other was directed to creating *advertisements* with designated content portions (see applicant's specification at page 3, lines 9-19 and page 8, line 22-page 9, line 28).

The subject matter of claim 30, corresponding to withdrawn claim 28, is directed to allowing a viewer to watch an advertisement or skip to a next commercial. As this particular feature is performed by appending information into the beginning portion of ***individual advertisements*** (see applicant's specification at page 3, lines 9-19, page 8, line 22-page 9, line 28), it is withdrawn from consideration, as this is directed to the non-elected invention.

The subject matter of claim 31, corresponding to withdrawn claim 29, is directed to presenting a *second* teaser to the viewer and pausing playing the program while after displaying the *second* teaser. As this particular feature is also performed by appending information into the beginning portion of ***individual advertisements*** (see applicant's specification at page 3, lines 9-19 and page 8, line 22-page 9, line 28), it is withdrawn from consideration, as this is directed to the non-elected invention.

These particular features are disclosed within applicant's specification as being directed towards *advertisements* with designated content portions, which was not

elected in the previous restriction requirement. While the claims themselves do not explicitly recite "*advertisements* with designated content portions", the claim limitations are clearly directed to this invention, as they are only disclosed in regards to this particular invention. Therefore, applicant's arguments are not convincing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 14, 16, 18 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (Zigmond) (6,698,020) (of record) in view of Balakrishnan et al. (Balakrishnan) (6,473,903) (of record).

As to claims 1, 16 and 32, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising:

a beginning portion of a commercial break (menu displayed prior to display of commercials; column 16, line 65-column 17, line 9);

wherein the beginning portion of the commercial break is of a particular length of time (wherein the user has a predetermined time to select an ad before a default is chosen; column 15, lines 45-65 and column 16, line 65-column 17, line 9) and has been authored to provide a teaser to entice a viewer to watch commercials during the commercial break (column 16, line 65-column 17, line 9) before the viewer causes a

DVR to skip through the commercial break (provided at the initiation of the commercial break; column 16, line 65-column 17, line 9); and

pausing playing of the program segment, by the DVR, after displaying the teaser (interrupting display of the program to present ads; column 15, lines 45-65). While Zigmond discloses that a menu corresponding to a beginning portion may be displayed (column 16, line 65-column 17, line 9), wherein the viewer is allowed to select a particular item in the menu (column 16, line 65-column 17, line 9), he fails to specifically disclose receiving, by the DVR, a program segment containing the beginning portion of the commercial break.

In an analogous art, Balakrishnan discloses a television distribution system (Fig. 3) wherein the user receiver will receive a program segment (set top receiving a "main program"; column 3, lines 20-38) containing a beginning portion of a commercial break (menu to display ad logos; column 3, line 40-column 4, line 9) for the typical benefit of allowing the broadcaster to provide users with an interactive advertising system wherein the users have a choice in which ad they wish to view (column 1, lines 8-25).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include receiving, by the DVR, a program segment containing the beginning portion of the commercial break, as taught in combination with Balakrishnan, for the typical benefit of allowing the broadcaster to provide users with an interactive advertising system wherein the users have a choice in which ad they wish to view.

As to claims 2 and 33, Zigmond and Balakrishnan disclose wherein the teaser is a set of images that indicate a commercial relating to a particular advertisement is present (see Zigmond at column 16, line 65-column 17, line 9 and Balakrishnan at column 3, lines 40-56).

As to claims 3 and 34, Zigmond and Balakrishnan disclose wherein the teaser is a short sequence of animations (see Zigmond at column 16, line 65-column 17, line 9 and column 9, lines 9-20 and Balakrishnan at column 3, lines 40-56).

As to claims 14 and 35, Zigmond and Balakrishnan disclose wherein the teaser is a menu (see Zigmond at column 16, line 65-column 17, line 9 and Balakrishnan at column 3, line 40-column 4, line 9) and the viewer is allowed to select a particular item in the menu (see Zigmond at column 16, line 65-column 17, line 9 and Balakrishnan at column 3, line 40-column 4, line 9).

As to claims 18 and 36, Zigmond and Balakrishnan disclose wherein the teaser is a tag that triggers the DVR to display a menu (see Zigmond at column 15, lines 45-65 and column 16, line 65-column 17, line 9 and Balakrishnan at column 3, lines 40-56 and Fig. 1).

Conclusion

6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with

all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER KELLEY whose telephone number is (571)272-7331. The examiner can normally be reached on Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/
Examiner, Art Unit 2424

JS